

## REMARKS

In the Office Action the Examiner noted that claims 20-21 are pending in the application, and the Examiner rejected both claims. The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested.

### Claim Rejections Under 35 USC §103

On pages 2-4 of the Office Action the Examiner rejected claims 20-21 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,091,808, issued to Wood et al. (hereinafter referred to as "Wood"), or, in the alternative, over Wood in view of U.S. Patent No. 6,870,828, issued to Giordano, III (hereinafter referred to as "Giordano"). The Applicants respectfully traverse the Examiner's rejections of these claims.

Claim 20 of the present application recites a system for dialing a telephone number retrieved via a first telephone line and the internet wherein "the user selects one of the retrieved and displayed telephone numbers, the web browser determines whether the selected telephone number is defined with a predetermined link syntax, and if the selected telephone number is defined with the predetermined link syntax, the telephone plug-in automatically dials the selected telephone number." The Applicants respectfully submit that at least this feature is not disclosed or suggested by the cited references.

Wood discloses a method in which a user is able to manage a telephone service and personal call database through remotely accessing a computer network facility (Column 2, Lines 6-56). It is apparent from the disclosure of Wood that the purpose of the method is to manage a personal service, as the web facility constitutes a web server interface for subscriber information and call management functions (Column 4, Lines 44-48). The primary interaction between the user and the interface is apparently managing a personal phone contact list, as shown in Figure 3, which can accordingly be added to and otherwise edited, and numbers in the list can be chosen to be placed in the editing windows 68 to be edited or dialed. In other words, in order to dial a number using the personal web server interface disclosed in Wood, a user would click on a number in his contact list, which would place the number in the editing window 68, and then press the dial button 75 to dial the same (Column 6, Lines 42-55). A user is also allowed to interact with a national directory, rather than his personal directory, by pressing the national button 65, which results in the national directory search window being placed in the frame 57 of the user's personal web server interface (Column 9, Lines 1-14). However, even when working

with the national directory as described above, the user must still copy and paste the number into the editing box 68 in order to store and/or dial the number (Column 9, Lines 1-14). This is in direct contrast to claim 20 of the present application, wherein "the user selects one of the retrieved and displayed telephone numbers, the web browser determines whether the selected telephone number is defined with a predetermined link syntax, and if the selected telephone number is defined with the predetermined link syntax, the telephone plug-in automatically dials the selected telephone number." Thus, Wood does not disclose or suggest at least this feature of claim 20.

The Examiner admits that there is a distinction between the manual method disclosed in Wood and the automatic dialing recited in claim 20 of the present application, but goes on to state that such a modification would have been obvious to one of ordinary skill in the art, stating that "[o]nce the user has the number it would be obvious to automatically dial the number independent of the web server in order to use up less resources." However, the Applicants would like to respectfully submit that this reasoning presented by the Examiner is not sound. To wit, the disclosure of Wood explicitly states that when pulling up the national directory, the search window of the national directory is presented in the search window to the subscriber in the frame 57 of the personal call management web page shown in Figure 3 (Column 9, Lines 7-10). Therefore, all interaction with the national directory, from the act of calling up the directory, to the user's interaction with the directory, to terminating the directory, is all performed through personal call management web page shown in Figure 3.

To set forth a *prima facie* §103 rejection, there must be some evidenced reason for modifying a reference. Specifically, there must be evidence, outside of the present application, which motivates, leads, or suggests to one of ordinary skill to modify a reference (MPEP 2141). As previously discussed, the only reason provided by the Examiner to modify the Wood reference, namely "to automatically dial the number independent of the web server in order to use up less resources," is actually contradicted by the disclosure of Wood. In other words, as the interaction has to go through the personal call management web page shown in Figure 3, not only is it not possible to dial the number independent of the web server, the modification suggested by the Examiner would actually use resources, which teaches away from the modification as reasoned by the Examiner. As provided in MPEP §2143.03, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F. 2d 1981, (CCPA 1974). Not only does Wood not teach or suggest at least the discussed feature of claim 20 of the present application, Wood actually teaches away from the modification suggested by the Examiner. Therefore, it is respectfully

submitted that claim 20 patentably distinguishes over Wood, and withdrawal of the §103(a) rejection is earnestly solicited.

The Examiner also rejected the claims as being obvious over Wood in view of Giordano, stating that Wood teaches the claimed limitations except for explicitly teaching automatically dialing based on the predetermined syntax and the communication channel being independent of the plug-in. The Examiner also stated that it would have been obvious to incorporate Giordano into Wood as nothing more than a design choice. However, as discussed above, the disclosure of Wood teaches away from automatically dialing the number at all, so there would be no reason to modify Wood with the disclosure of Giordano, much less that of a "design choice."

Further, there are other reasons to not incorporate Giordano into the disclosure of Wood. Giordano discloses a method of searching HTML documents for telephone number information which is presented as plain text, rather than provided as hyper links, and converting those pages so that the telephone information can be treated as a hyper link. Once again, this combination would be contradicted by the stated modification reason of the Examiner, because this would cause an even more complicated process, which would in turn use up more valuable resources. Further, the disclosure of Wood pertains to managing a user's personal call database, so it is apparent that any number found through a national directory would be desired to place in the editing windows 68 so that it may be stored in the call database, thus precluding the user from having to look up the number again at a later date.

Therefore, Wood teaches away from the combination of Wood and Giordano. MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper." Here, the Examiner has simply stated, with no evidence to support the assertion, that incorporating the teachings of Giordano into Wood would be obvious "as nothing more than a design choice." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner

must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). Here, the purpose of the Wood reference is maintaining a personal call database which is accessed through a call management web page. Therefore, there is no action that would be taken by the user of Wood that would be independent of the plug-in, as stated by the Examiner, and further the entire motivation behind Wood, i.e., the management of the user's call database, would be circumvented by any combination with a method such as disclosed in Giordano, which would prevent the user from storing the searched for telephone number in the personal call database through the call management web page. Therefore, the Wood reference teaches away from the disclosure of Giordano, and the Applicant respectfully submits that claim 20 patentably distinguishes over the combination of the cited references.

Claim 21 of the present application recites a system for dialing a telephone number retrieved via a telephone line and the internet wherein "the user selects one of the retrieved and displayed telephone numbers, the information terminal automatically disconnects the web browser from the telephone line, the web server and the internet and if the web browser determines that the selected telephone number is defined with a predetermined link syntax, the telephone plug-in automatically dials the selected telephone number independently of the web server." As discussed in relation to claim 20 of the present application, the national directory page is displayed through the call management web page in the disclosure of Wood, therefore at no time would the web browser be disconnected from the telephone line, because that would result in the loss of the call management web page capabilities. Therefore, not only does the Wood reference teach away from any modification discussed by the Examiner or a combination with Giordano, any such combination is apparently contradicted by the disclosure of Wood. Thus, at least this feature of claim 21 is not disclosed by the cited references, either alone or in combination, and the Applicants respectfully submit that claim 21 also patentably distinguishes over the cited references.

### Summary

It is respectfully submitted that none of the cited references, either taken alone or in combination, disclose or suggest the present invention. There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 01/18/06

By: Thomas L. Jones  
Thomas L. Jones  
Registration No. 53,908

1201 New York Avenue, NW, Suite 700  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501